

I hereby certify that this correspondence is being deposited with the United States Postal Service, with sufficient postage, as first class mail in an envelope addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

on August 25, 2003

Date of Deposit

David W. Okey

Name of appellants, assignee or  
Registered Representative

*David W. Okey*

Signature

*August 25, 2003*

Date of Signature

th16  
Brief  
E-fax  
9/4/03

Our Case No. 5658-746

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Poole et al. )  
Serial No. 09/911,242 )  
Filing Date: July 23, 2001 ) Examiner: Debra S. Meislin  
For: ONE HAND PIPE WRENCH ) Group Art Unit No. 3723  
 )  
 )  
 )

**APPEAL BRIEF**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**

SEP 02 2003

TECHNOLOGY CENTER R3700

06/29/2003 AWONDAF1 00000009 09911242

01 FC:1402

320.00 OP

## TABLE OF CONTENTS

I. Real Party in Interest	3
II. Related Appeals and Interferences	3
III. Status of Claims	3
IV. Status of Amendments	3
V. Summary of Invention	4
VI. Issues	5
VII. Grouping of Claims	5
VIII. Argument	6
IX. Appendix (Claims 4-10 and 16-29)	16

This is an appeal from the final rejections in the Office Action mailed on February 28, 2003 (Paper No. 11) for the application of Daniel L. Poole et al., and is timely filed in accordance with the Notice of Appeal filed on June 27, 2003.

### **I. Real Party in Interest**

The real parties in interest are the assignee, American Tool Companies, Inc., its successor, Irwin Industrial Tool Co., and their parent company, Newell-Rubbermaid, Inc.

### **II. Related Appeals and Interferences**

There are no related appeals or interferences that would affect, be affected by, or have a bearing upon, the Board's decision in the present appeal in this application.

### **III. Status of Claims**

Claims 4-10 and 16-29 are pending in this application. Claims 1-3 and 11-15 have been cancelled. Claims 4-10, 16-20, and 28 are finally rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter the applicants' regard as the invention.

Claims 4-7, 16-17, and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 766,145 to William Greer ("Greer") in view of U.S. Pat. No. 218,195 to Henry Rhyn ("Rhyn"). Claims 8-10, 18-20, and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greer in view of Rhyn in view of U.S. Pat. No. 2,543,824 to Beesley et al. ("Beesley"). Claims 21-27 are rejected under 35 U.S.C. §103(a) over Greer in view of Beesley.

### **IV. Status of Amendments**

The last Amendment filed in this case was mailed by Appellants on April 28, 2003, in response to the final rejection mailed on February 28, 2003 (Paper No. 11). The Amendment was entered. No other amendments are pending.

## V. Summary of Invention

A first embodiment of the present invention is a pipe wrench. Pipe wrench 10 has a slide bar 12 with rounded corners and a series of teeth 30 for engagement of the lower jaw 22. In a preferred embodiment, a series of teeth is cut into one face of the lower jaw, so that in combination with a brake lever 32, a ratcheting mechanism is formed. Only when a user depresses brake lever 32 may lower jaw 22 be opened. The slide bar 12 has an upper portion with an upper jaw 14 and a lower portion with a gripping means 16. The upper jaw 14 is preferably pivotally connected to the slide bar by pivot pin 18. Upper jaw 14 may also have a gripping surface 20 attached. Specification, p. 4, lines 15-23. Lower jaw 22 may have a gripping surface 26, or a thumb-resting portion, attached to the lower jaw. Specification, p. 4, lines 23-25, and p. 8, line 15. This portion facilitates movement of the lower jaw by a thumb of an operator. Lower jaw 22 slides along slide bar 12, controlled by the brake lever 32, which interfaces with teeth 30 on slide bar 12. Brake lever 32 is generally in the shape of a right angle, with one portion perpendicular to the slide bar, and another, operating portion generally parallel to the slide bar and extending from the perpendicular portion in the direction of the gripping surface, for most of the length of the lower jaw from that point. In one embodiment, the surface of brake lever 32 is smooth, and the surface of lower jaw 22 in the region of the brake lever has a knurled or ridged surface area 26. Specification, p. 4, line 25, to p. 5, line 3.

Brake lever 32 extends downwardly toward the gripping portion of the wrench, the brake lever extending sufficiently far that a user's thumb may easily actuate brake lever 32 via knurled portion 26 while the remainder of the user's hand remains on the gripping portion. Thus, it is possible to adjust the lower jaw using only one hand. Brake lever 32 straddles the slide bar 12 and the downwardly-extending portion of the brake lever fits partially into a cavity 28 defined in the lower jaw. The slide bar 15 may have square corners rather than round. Slide bar 15 fits into gripping portion 17, and fits through lower jaw 19, mating with upper jaw 21, all through squared-off orifices or mating features. The slide bar also fits through a square cavity 23 of the brake lever 25. The wrench may be configured with sharp corners or rounded corners. Specification, p. 5, lines 4-17.

## **VI. Issues**

The issues on appeal are as follows: 1) whether there is error in the final rejection of Claims 4-10, 16-20 and 28 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter the applicants' regard as the invention; 2) whether there is error in the final rejection of Claims 4-7, 16-17, and 29 as being unpatentable under 35 U.S.C. § 103(a) over U.S. Pat. No. 766,145 to William Greer in view of U.S. Pat. No. 218,195 to Henry Rhyn; 3) whether there is error in the final rejection of Claims 8-10, 18-20, and 28 under 35 U.S.C. § 103(a) over U.S. Pat. No. 766,145 to William Greer in view of U.S. Pat. No. 218,195 to Henry Rhyn, and further in view of U.S. Pat. No. 2,543,824 to Beesley et al.; 4) whether there is error in the final rejection of Claims 21-27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 766,145 to William Greer in view of U.S. Pat. No. 2,543,824 to Beesley et al.

## **VII. Groupings of Claims**

The Claims do not stand or fall together with regard to rejections over the prior art. In order to separately consider a plurality of claims subject to the same rejection, the Appellants must state that the claims do not stand or fall together and present arguments why the claims are separately patentable. In re McDaniel, 63 U.S.P.Q.2d 1462, 1464 (Fed. Cir. 2002) (citing M.P.E.P. 1206 and 37 C.F.R. 1.192(c)(7)). Arguments for the claim groups listed below are presented in the arguments section. Accordingly, Appellants provide the following claim groups:

The patentability of Claims 4, 5, 7, 16, 17 and 29 stand or fall together.

The patentability of Claim 6 stands alone.

The patentability of Claims 8, 9, 10, 18, 19 and 20 stand or fall together.

The patentability of Claims 21-23 stand or fall together.

The patentability of Claims 24-27 stand or fall together.

The patentability of Claim 28 stands alone.

## VIII. Argument

### ii. Rejections under 35 U.S.C. § 112, second paragraph.

The Office Action rejected Claims 4-10, 16-20 and 28 under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter the applicants regard as their invention. Claims 5-10 depend from Claim 4 and Claims 17-20 and Claim 28 depend from Claim 16. The Examiner suggested corrections to Claims 4 and 16, which corrections were made in an amendment mailed on April 28, 2003. The amendment should be sufficient to remedy any indefiniteness in Claims 4-10, 16-20, and 28, as cited by the Examiner. It is therefore error to continue to reject these claims under § 112, second paragraph.

Appellants believe that the Amendments made per the Examiner's suggestion, mailed on April 28, 2003, and entered by the Examiner, remove the rejections under 35 U.S.C. § 112, second paragraph, as being indefinite. In an advisory action mailed on May 23, 2003 (Paper No. 13), the Examiner noted that the Amendment was entered but that the Amendment does not place the application in form for allowance because "the Examiner remains of the opinion that the applied references disclose the claimed subject matter as set forth in the previous office action." Although Appellants believe the issue with respect to 35 U.S.C. § 112, second paragraph, has been settled, Appellants raise the issue on appeal because there has been no clear-cut statement that the issue has been settled. } has

### iv. Rejections under 35 U.S.C. § 103(a)

#### Claims 4, 5, 7, 16, 17 and 29

Claims 4, 5, 7, 16, 17 and 29 are finally rejected under 35 U.S.C. § 103(a) in view of U.S. Pat. No. 766,145 to William Greer ("Greer") in view of U.S. Pat. No. 218,195 to Henry Rhyn ("Rhyn"). The rejection states that Greer discloses all of the claimed subject matter except for having a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw, but that Rhyn discloses a pivotally

mounted upper jaw with a spring biasing the upper jaw toward the lower jaw. Office Action, p. 2, line 22-25 (hereinafter a reference to the "Office Action" refers to Paper No. 11, mailed on February 28, 2003). The rejection states that it would have been obvious to one having ordinary skill in the art to form the device of Greer with a spring biasing the lower jaw to grip the workpiece as taught by Rhyn. Appellants traverse the rejection on the grounds that there is insufficient motivation to combine the references. Furthermore, even combined, the references do not teach all the limitations of the inventions claimed in Claims 4, 5, 7, 16, 17 and 29.

A. There is insufficient motivation to combine the references.

The Office Action concedes that Greer does not disclose a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw. The Office Action cites Rhyn as disclosing a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw. As stated above in the section on rejections, the rejection states that it would have been obvious to one having ordinary skill in the art to form the device of Greer with a spring biasing the upper jaw toward the lower jaw to grip the workpiece as taught by Rhyn. Greer argues against any pivoting motion, describing a rigid jaw in which

both of the members 6 and 7 are readily operated by manipulation of the finger-piece 10, so as to effect a simultaneous unclutching movement of these parts whenever it becomes necessary to throw the movable jaw away from the rigid jaw.

Greer, col. 3, lines 22-28 (emphasis added). Thus, Greer teaches the benefits of a very rigid jaw. Combining Greer with Rhyn, to add the pivoting jaw, thus changes the operating principle of Greer.

A wrench with a single bar may be changed to have a pivot point; but a wrench such as Greer's, with two bars forming the shank, cannot have a pivot point about which the upper jaw can pivot. Even if one were to replace one of the two bars with a pivot point, the other bar, holding the jaw rigidly, would not pivot or allow a pivoting motion. Greer thus teaches against any wrench in which there would be a movable or pivoting upper jaw, since Greer is emphatic in describing an upper jaw that is held very rigidly on the handle of the wrench. Greer states,

The wrench is very substantial, and the provision of the double clutch members 6 and 7 is advantageous in that the jaw is firmly held in an ascertained position with the said members are engaging the shank 1.

Greer, col. 3, lines 18-22 (emphasis added). Thus, Greer teaches the advantages of a substantial, rigid grip of the jaw by the shank, rather than teaching of any need for a pivoting upper jaw.

Rhyn teaches a pipe-wrench with a pivotable upper jaw, but with a lower jaw that is only movable by means of an adjustment nut. There is no suggestion in Rhyn to replace Greer's rigid jaw with a pivoting jaw. Furthermore, as stated previously, Greer teaches away from such a combination since Greer requires the jaw to be firmly held in its ascertained position. The references would have suggested to one of ordinary skill in the art that there could be no combination, since Greer teaches a rigid jaw with no possibility of a pivot point, while Rhyn teaches a pivoting upper jaw with a clumsy movement in the lower jaw. As stated above, only impermissible hindsight will succeed in combining these contradictory references. Therefore, the first condition stated in M.P.E.P. § 2143 for establishing a *prima facie* case of obviousness, the motivation for combining the references, is not met.

Using a movable upper jaw is squarely against the teachings and emphasis of Greer, and completely changes the operating principle of the wrench. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. 2143.01 at 2100-127. Using a pivoting upper jaw in Greer's wrench would change the principle of operation of Greer's wrench. Therefore, the teachings of the references are not sufficient to render the claims obvious. Accordingly, the final rejection of Claims 4, 5, 7, 16, 17 and 29 under 35 U.S.C. § 103(a) is error.

B. The improperly combined references do not include all the limitations of the claimed invention.

The rejection concedes that Greer does not include the limitation of an upper jaw mounted pivotally to a slide bar and a spring mounted between the upper jaw

and the slide bar. In addition, the cited references do not disclose another limitation of the inventions claimed in Claims 4, 5, 7, 16, 17 and 29. In particular, Claim 4 recites "a brake lever, pivotally mounted on a portion of the lower jaw and spring-biased against said lower jaw wherein a portion of the lever extends longitudinally and substantially the same length toward the gripping portion as the lower portion extends longitudinally toward the gripping portion."

As can easily be seen in Figs. 1 and 2 of Greer, finger-piece 11 does not extend longitudinally and substantially the same length toward the gripping portion (handle 3) as the lower portion of the lower jaw (no numeral). "The finger-piece constitutes a housing for the spring 9 to prevent lodging of foreign matter between the coils of this spring, which might interfere with the proper working thereof." Col. 3, lines 13-17. Finger-piece 11 is "extending laterally from the upper end thereof and overlapping the upper end of the clutch member 7, as well as the spring 9." Col. 3, lines 6-8. Figs. 1 and 2 are in agreement with this description, depicting finger-piece 11 as extending as far as clutch members 6 and 7, and overlapping spring 9. Finger-piece 11, however, does not meet the limitation of Claims 4, 5, 7, and 29, that it "extends longitudinally and substantially the same length toward the gripping portion as the lower portion extends longitudinally toward the gripping portion." Claim 16, and hence dependent Claim 17, recite a slightly different limitation, in that the brake lever, "pivotally mounted on one of said portions of the lower jaw and spring-biased against said second portion of the lower jaw, wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the second portion extends longitudinally toward the gripping portion." In addition, Rhyn does not describe or suggest such a brake lever.

Thus, the cited references do not disclose all the limitations of the inventions claimed in Claims 4, 5, 7, 16, 17 and 29. There is insufficient motivation for combining the references, at least for the purpose of adding a pivoting upper jaw, which changes the operating principle of Greer. Therefore, it was error to finally reject Claims 4, 5, 7, 16, 17 and 29 of the application under 35 U.S.C. § 103(a).

### Claim 6

Claim 6 was rejected under 35 U.S.C. § 103(a) over Greer in view of Rhyn. Claim 6 depends from Claim 4 and therefore its rejection is improper for the reasons stated above with respect to Claim 4. The rejection of Claim 6 is improper for the additional reason that at least one limitation of Claim 6, a limitation "wherein the lower jaw has a thumb-resting portion to facilitate movement by a thumb of an operator," is not disclosed or taught in the cited references. Rhyn has no thumb-resting portion. Greer discloses a gripping surface on the "finger-piece" or lever, rather than on the lower jaw. The difference is significant. It is much more difficult to move the jaw using a gripping surface on the "finger-piece" or lever, simply because the mass of metal to be moved is more concentrated in the jaw than in the lever. In addition, with the thumb acting on the "thumb-resting" portion of the lower jaw, and the brake lever accessible to the thumb in this area (as in the embodiments of the claimed present invention), the user does not have to extend his or her hand away from the preferred gripping portion, and higher, in the direction of the first portion of the lower jaw or toward the upper jaw. The prior art does not show this specific limitation of the invention claimed in Claim 6 of the present application.

A rejection of claims based on a combination of elements disclosed in the prior art must be based on the *specific* combination that was made by the applicant. In re Kotzab, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (emphasis added). There is no specific disclosure in Greer of a lower jaw with a thumb-resting portion; there is no mention in Rhyn of a thumb-resting portion. The improperly-combined references do not disclose all the limitations of the inventions claimed in Claim 6 of the present application. Even if the references disclosed the limitations of Claim 6, the rejection would be in error because the combination changes the operating principle of Greer, and one would not be sufficiently motivated to combine Greer and Rhyn. Therefore, it was error to finally reject Claim 6 under 35 U.S.C. § 103(a).

### Claims 8-10 and 18-20

Claims 8-10 and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Greer in view of Rhyn in view of Beesley. As noted above in the

section on Claims 4, 5, 7, 16, 17, and 29, neither Greer nor Rhyn discloses or suggests "a brake lever, pivotally mounted on a portion of the lower jaw and spring-biased against said lower jaw wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the lower portion extends longitudinally toward the gripping portion," as recited in Claim 4, or as recited in Claim 16, "a brake lever, pivotally mounted on one of said portions of the lower jaw and spring-biased against said second portion of the lower jaw, wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the second portion extends longitudinally toward the gripping portion."

Beesley does not cure the deficiencies of Greer and Rhyn. Beesley discloses a wrench having a pivoting upper jaw and slidable lower jaw with a pivoted rack catch on the inner portion. The catch or lever, however, does not extend longitudinally, but at an angle, and does not extend substantially the same length toward the gripping portion as the second portion extends longitudinally toward the gripping portion; instead, it extends only a short length.

Accordingly, the Office Action has not established a sustainable rejection that Claims 8, 9, 10, 18, 19 and 20 are unpatentable in view of the prior art. Therefore, it was error to finally reject Claims 8, 9, 10, 18, 19 and 20 under 35 U.S.C. § 103(a).

#### Claim 28

The Office Action also rejects Claim 28 as unpatentable under 35 U.S.C. § 103(a) over Greer, in view of Rhyn and Beesley. Appellants traverse this rejection. Claim 28 depends from Claim 16. As mentioned above in the arguments for Claims 4, 5, 7, 16, 17 and 29, neither Greer, Rhyn, or Beesley disclose or suggest "a brake lever, pivotally mounted on one of said portions of the lower jaw and spring-biased against said second portion of the lower jaw, wherein a portion of the lever extends longitudinally and substantially the same length towards the gripping portion as the second portion extends longitudinally toward the gripping portion."

The rejection is improper for the additional reason that none of the references describes or suggests an additional limitation of Claim 28, that "the lower jaw is subject to motion toward the upper jaw when the lever is engaged, and is subject to

motion to and from the upper jaw when the lever is disengaged." Accordingly, the Office Action has not established a *prima facie* case of unpatentability for Claim 28, in accordance with M.P.E.P. § 2143. Therefore, it was error to finally reject Claim 28 under 35 U.S.C. § 103(a).

### Claims 21-23

The Office Action finally rejected Claims 21-23 as being unpatentable over Greer in view of Beesley under 35 U.S.C. § 103(a). The rejection concedes that Greer does not disclose a pivotally mounted upper jaw with a spring and Greer also does not disclose a ratcheting mechanism/incremental teeth on the slide for engagement with the brake. The rejection also states that Beesley discloses these limitations. The rejection is in error on at least two grounds: there is insufficient motivation to combine the references, and even the improperly-combined references do not disclose all the limitations of the inventions claimed in Claims 21-23.

#### A. There is no motivation to combine the cited references.

For motivation to combine, the Examiner states that it would have been obvious to one having ordinary skill in the art to form the device of Greer with a pivotally mounted upper jaw with a spring and a ratcheting mechanism/incremental teeth on the slide for engagement with the brake to allow the jaws to be adjusted to grip a workpiece as taught by Beesley. Greer and Beesley cannot be combined because Greer demands a rigid upper jaw, preferably including a shaft that is bent back upon itself and cannot be used for a pivoting upper jaw. Greer, col. 1, lines 39-44. While Greer uses a plain shaft, bent back upon itself, with no ratcheting mechanism or incremental teeth, Beesley uses a pivoting upper jaw and a ratcheting mechanism with incremental teeth. As noted above for Claim 4, modifying Greer with a pivotable upper jaw changes the operating principle of Greer. Thus, the teachings of the references are not sufficient to render Claims 21-23 obvious. M.P.E.P. 2143.01 at 2100-127.

One would not be motivated to combine Greer with Beesley. Greer teaches a pipe wrench in which the user uses a thumb of the gripping hand to advance the lower jaw toward the upper jaw, and in which the user need only depress the finger-

piece in order to allow the lower jaw to move away from the upper jaw. The wrench of Greer is relatively simple and straightforward, and can be operated easily by one hand, with the thumb of that hand used to actuate the lever and clutch provided. Beesley has a far more complicated arrangement, using a ratcheting mechanism and incremental teeth, and a very awkward pawl operated by a finger to release the lower jaw from the pawl so that the lower jaw can be opened. Note that in Beesley, the pawl releases the lower jaw by a thumb or a finger pressing on lever or finger 80 away from the wrench, and also away from a user's natural tendency (see Figs. 1 and 2). At least because of the awkward mechanism, a user would not be motivated to combine Greer with Beesley.

B. The improperly combined references do not include all the limitations of the claimed invention.

Claim 21 has additional limitations not cited in the rejection and not present in the improperly combined references. Claim 21 is a method claim, with a step of adjusting a gap between the jaws of a hand tool, using a lower jaw and a brake lever, "wherein a portion of the lever extends longitudinally and substantially the same length toward the gripping portion as the lower portion extends longitudinally toward the gripping portion." Beesley clearly has no component that meets these limitations. The only possibilities in Greer are the clutches 6, 7 and the finger-piece 11. As can be seen clearly in Figs. 1 and 2, finger piece 11 does not extend longitudinally and substantially the same length toward the gripping portion as the lower portion extends longitudinally toward the gripping portion. Accordingly, the Examiner has not established a *prima facie* case of unpatentability for Claim 21, in accordance with M.P.E.P. § 2143.

Therefore, even the improperly combined references do not describe or suggest all the limitations of the claimed invention. It was error to finally reject Claims 21-23 under 35 U.S.C. § 103(a) over Greer in view of Beesley.

Claims 24-27

The Office Action rejects independent Claim 24, and dependent Claims 25-27, under the same rationale as Claims 21-23 above, as being unpatentable over Greer in view of Beesley. The rejection states that Greer discloses all of the claimed

subject matter except for having a pivotally mounted upper jaw with a spring, and also does not disclose a ratcheting mechanism/incremental teeth on the slide for engagement with the brake. Office Action, p. 2, lines 12-14. The rejection also states that Beesley discloses these elements. The rejection is in error because it is improper to combine the references, and even the improperly-combined references do not disclose or suggest all the limitations of the inventions claimed in Claims 24-27.

By the same arguments discussed above with respect to Claims 21-23, there is insufficient motivation to combine Greer with Beesley, because Greer teaches against a wrench with a movable jaw. Greer teaches a very substantial wrench in which there is a rigid jaw and a movable jaw. The rigid jaw is rigid because it is held in place by two portions of a shank formed from a bar bent back upon itself. Thus the shank of Greer includes two parallel shafts joined to an upper jaw and holding the upper jaw rigid and immovable. Beesley teaches a much more complicated mechanism, with a pivoting upper jaw. As discussed with respect to Claims 8-10 and 18-20, one would not be motivated to combine Greer with Beesley because the teachings are contradictory and would change the operating principle of Greer. As noted above in the section on Claims 4, 5, 6, 16, 17, and 29, even if one portion of the shank formed from Greer were replace by a pivot point, the other portion would prevent pivoting of the upper jaw.

Even if the Greer is combined with Beesley, the combination does not teach all the limitations of the claimed invention. Claim 24 claims at least one limitation not present in Greer or Beesley, namely, "a brake lever, pivotally mounted on the lower jaw and spring-biased on the second portion of the lower jaw, wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the second portion extends longitudinally toward the gripping portion." As can be seen in at least Figs. 1 and 2 of Greer, finger-piece 11 does not even approach the lower jaw, and thus does not meet this limitation of Claim 24. Therefore, not all the claim limitations of the rejected claim are taught or suggested by the references, as required by M.P.E.P. 2143.03.

The specific limitation of the easy-to-use brake lever of the present invention is not taught and, therefore, the Examiner has not shown that the specific

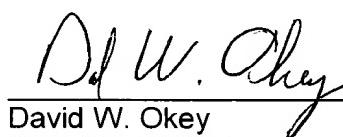
combination of elements claimed in Claims 24-27 was disclosed or suggested in the prior art. Therefore, it was error to finally reject Claims 24-27 under 35 U.S.C. § 103(a). Even if the references disclosed the limitations of Claims 24-27, the rejection is error because one would not be sufficiently motivated to combine the references, and the combination would change the operating principle of Greer.

### CONCLUSION

In view of the above remarks, Appellants submit that the claimed invention is not unpatentably obvious over the references of record, and that the Office Action has not made out a sustainable case of obviousness for Claims 4-10 and 16-29. Furthermore, it is error to continue to reject claims for indefiniteness after the claims have been amended to cure the indefiniteness. Accordingly, Appellants request reversal of the rejections of Claims 4-10 and 19-29 under 35 U.S.C. § 103(a). Appellants also request reversal of the rejection of Claims 4-10, 16-20, and 28 under 35 U.S.C. § 112, second paragraph. The reversal of all the rejections appears to be in order and is earnestly solicited.

The fee under 37 C.F.R. 1.17 (f) for filing this Appeal Brief is submitted with the accompanying transmittal.

Respectfully submitted,

  
\_\_\_\_\_  
David W. Okey  
Reg. No. 42,959  
Attorney for Appellants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

## **IX. Appendix Claims in the Application**

4. An adjustable pipe wrench, comprising:
  - a slide bar having a gripping portion;
  - an upper jaw mounted pivotally to the slide bar and a spring mounted between the upper jaw and the slide bar;
  - a lower jaw, slidably mounted on the slide bar, said lower jaw having a lower portion extending toward the gripping portion; and
  - a brake lever, pivotally mounted on a portion of the lower jaw and spring-biased against said lower jaw wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the lower portion extends longitudinally toward the gripping portion, and wherein a user may adjust a position of the lower jaw on the slide bar by actuating said lever and moving said lower jaw relative to said slide bar.
5. The wrench of Claim 4, wherein the lever has an operation portion angled so it extends generally parallel to the slide bar.
6. The wrench of Claim 4, wherein the lower jaw has a thumb-resting portion to facilitate movement by a thumb of an operator.
7. The wrench of Claim 4, wherein the lever has an orifice for slidably mounting around the slide bar.
8. The wrench of Claim 4, wherein the slide bar further comprises a ratcheting mechanism, said ratcheting mechanism including a surface of the brake lever and teeth on a surface of the slide bar.
9. The wrench of Claim 8, wherein the ratcheting mechanism advances said lower jaw toward said upper jaw in increments.

10. The wrench of Claim 4, further comprising gripping surfaces on the upper jaw and lower jaw.

16. An adjustable hand clamp, comprising:

a slide bar having a gripping portion;

an upper jaw mounted pivotally to the slide bar and a spring mounted between the upper jaw and the slide bar;

a lower jaw, slidably mounted on the slide bar, said lower jaw having a first portion on a first side of the slide bar extending toward the upper jaw and a second portion on a second side of the slide bar extending in an opposite direction toward the gripping portion; and

a brake lever, pivotally mounted on one of said portions of the lower jaw and spring-biased against said second portion of the lower jaw, wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the second portion extends longitudinally toward the gripping portion, and wherein a user adjusts a position of the lower jaw on the slide, by repositioning the lower jaw with a thumb.

17. The clamp of Claim 16, wherein the lever has an orifice for slidably mounting around the slide bar.

18. The clamp of Claim 16, wherein the slide bar further comprises a ratcheting mechanism, said ratcheting mechanism including a surface of the brake lever and teeth on a surface of the slide bar.

19. The clamp of Claim 18, wherein the ratcheting mechanism advances said lower jaw toward said upper jaw in increments.

20. The clamp of Claim 16, further comprising gripping surfaces on the upper jaw and lower jaw.

21. A method of grasping an object with one hand using an adjustable hand tool having a brake lever, the method comprising:

providing the object and the hand tool;

gripping the hand tool with one hand;

adjusting a gap between jaws of the hand tool with the same hand, using a lower jaw and a pivotable upper jaw of the hand tool, wherein the lower jaw has a lower portion extending toward a gripping portion of the hand tool, and the brake lever of the hand tool is pivotally mounted on a portion of the lower jaw, and wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the lower portion extends longitudinally toward the gripping portion; and

grasping the object.

22. The method of Claim 21, further comprising disengaging a brake lever of the hand tool, the brake lever extending substantially the same longitudinally as a lower jaw of the hand tool; and engaging the brake lever of the hand tool.

23. The method of Claim 21, further comprising tightening a grasp on the object, urging the pivotable upper jaw and a moving lower jaw to grasp the object more tightly, wherein the hand partially rotates the hand tool about the object and presses the lower jaw toward the upper jaw.

24. An adjustable pipe wrench, comprising:
- a slide bar having a gripping portion;
  - a pivotable upper jaw mounted to the slide bar;
  - a lower jaw, slidably mounted on the slide bar, said lower jaw having a first portion extending toward the upper jaw and a second portion extending in an opposite direction toward the gripping portion; and
- a brake lever, pivotally mounted on the lower jaw and spring-biased on the second portion of the lower jaw, wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the second portion extends longitudinally toward the gripping portion, and wherein the brake lever and the slide bar form a bar-engaging mechanism, and a user may open the jaws with a thumb, disengaging the brake lever from the slide bar and urging the lower jaw away from the upper jaw.
25. The adjustable wrench of Claim 24, wherein the user closes the jaws of the wrench by pushing the lower jaw toward the upper jaw with the thumb.
26. The adjustable wrench of Claim 24, wherein the bar-engaging mechanism further comprises teeth on a surface of the slide bar, wherein the brake lever engages the teeth and prevents opening of the jaws.
27. The adjustable wrench of Claim 24, further comprising a spring mounted between the upper jaw and the slide bar.
28. The clamp of Claim 16, wherein the lower jaw is subject to motion toward the upper jaw when the lever is engaged, and is subject to motion to and from the upper jaw when the lever is disengaged.

29. An adjustable pipe wrench, comprising:

a slide bar having a gripping portion;

a lower jaw slidably mounted on the side bar, said lower jaw having a lower portion extending toward the gripping portion

an upper jaw having a gripping surface, said upper jaw mounted pivotally to the slide bar and having a spring captured between said upper jaw and said slide bar, said spring biasing said upper jaw so that the gripping surface of said upper jaw is biased toward said lower jaw; and

a brake lever, pivotally mounted on a portion of the lower jaw and spring-biased against said lower jaw wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the lower jaw extends longitudinally toward the gripping portion, and wherein a user may adjust a position of the lower jaw on the slide by actuating said lever and moving said lower jaw relative to said slide bar.